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JQ

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB APRIL 11, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Melamine Chemicals, Inc.

Serial Nos. 74/406,483; 74/406,485; 74/546,552; and
74/546,554

Request for Reconsideration

Theodore A. Breiner of Breiner & Breiner for applicant.

Carolyn C. Gray, Trademark Examining Attorney, Law Office
111 (Craig Taylor, Managing Attorney).

Before Quinn, Walters and Wendel, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

Applications have been filed by Melamine Chemicals,
Inc. to register the mark MELAMINE CHEMICALS, INC. and the
mark shown below

for "chemicals, namely, melamine"¹ and "providing technical consultation services in the field of melamine."² In each application, applicant claims that the mark sought to be registered has acquired distinctiveness as provided by Section 2(f) of the Trademark Act.

The Board, in a decision dated August 11, 1999, affirmed the refusals to register, finding that the marks sought to be registered were generic and, thus, incapable of functioning as trademarks/service marks. The Board went on to find that even if these marks were capable of functioning as trademarks and service marks, the evidence of acquired distinctiveness was insufficient to establish that the involved marks had acquired distinctiveness when used in connection with applicant's goods and services.

Applicant filed a timely request for reconsideration. The request was based, in main part, on a then-recent decision of the United States Court of Appeals for the Federal Circuit, the Board's primary reviewing court, which decision issued shortly after the Board's decision in the

¹ Respectively, application serial nos. 74/406,483, filed June 28, 1993, alleging dates of first use of 1968, and 74/546,552, filed July 7, 1994, alleging dates of first use of 1988.

² Respectively, application serial nos. 74/546,554, filed July 7, 1994, alleging dates of first use of 1968, and 74/406,485, filed June 28, 1993, alleging dates of first use of 1988.

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present case. See: In re The American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1831 (Fed. Cir. 1999).

In view of the Federal Circuit's decision, the Board, on October 15, 1999, granted the request for reconsideration to the extent that the Board's decision of August 11, 1999 was vacated.³ Before ruling on the merits of the request for reconsideration, however, the Board allowed the Examining Attorney an opportunity to submit a brief in response to the request for reconsideration. Accordingly, the application file was forwarded to the Examining Attorney for further consideration of registrability in light of the case of In re The American Fertility Society, supra.

The Examining Attorney filed, on December 8, 1999, a supplemental brief.⁴ The Examining Attorney maintained the refusal to register, essentially reiterating her position that the dictionary definitions of the terms "melamine" and "chemicals" satisfy the Office's burden in showing that the

³ Familiarity is presumed, nonetheless, with the Board's earlier decision. Thus, the Board sees no reason to recount in great detail the respective arguments or applicant's evidence.

⁴ Although the brief was due November 14, 1999, it was filed late "due to illness and resultant absence on behalf of the Examining Attorney." In view of the circumstances, the late-filed brief is accepted and will be considered.

mark as a whole is generic for applicant's goods and services.

We now turn to the merits of applicant's request for reconsideration. The Federal Circuit vacated the Board's decision in American Fertility , supra, upon finding that the Board had applied an incorrect legal test in determining genericness. The Federal Circuit held that the Office failed to carry its burden to establish the relevant purchasing public's understanding of the phrase SOCIETY FOR REPRODUCTIVE MEDICINE as it relates to the applicant's services. The Federal Circuit stated that "[t]he Board cannot simply cite definitions and generic uses of the constituent terms of a mark...in lieu of conducting an inquiry into the meaning of the disputed phrase as a whole to hold a mark...generic." The Federal Circuit went on to state that the prior case of *In re Gould Paper Corp.*, 835 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) "is limited, on its facts, language, and holding, to compound terms formed by the union of words" and that it was legally erroneous to apply language found in the Gould case "to phrases consisting of multiple terms, which are not 'joined' in any sense other than appearing as a phrase." The Federal Circuit went on to state that the "correct legal test...is set forth in *Marvin Ginn* and is to be applied to a mark, or

disputed phrase thereof, as a whole, for the whole may be greater than the sum of its parts." The Federal Circuit concluded as follows:

The correct legal test for genericness of phrases, as set forth in *Marvin Ginn*, requires evidence of "the genus of goods or services at issue" and the understanding by the general public that the mark refers primarily to "that genus of goods or services." *Gould* provides additional assistance in determining the genericness of compound words only, and holds that if the PTO can prove (1) the public understands the individual terms to be generic for a genus of goods and species; and (2) the public understands the joining of the individual terms into one compound word to lend no additional meaning to the term, then the PTO has proven that the general public would understand the compound term to refer primarily to the genus of goods or services described by the individual terms. The PTO here failed to provide any evidence that the phrase as a whole, SOCIETY FOR REPRODUCTIVE MEDICINE, has acquired no additional meaning to the relevant public than the terms "society" and "reproductive medicine" have individually. The Board must now apply the *Marvin Ginn* test to the phrase as a whole, and not focus only on the individual terms.

The applied-for MELAMINE CHEMICALS, INC. mark does not appear to be a single compound word, as was the case of "screenwipe" in the *Gould* case. We thus focus our attention on the test set forth in *Marvin Ginn*. H. Marvin

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Ginn Corp. v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

The genus of goods here clearly is melamine and melamine-related services. We then consider whether MELAMINE CHEMICALS, INC. is understood by the relevant public primarily to refer to that genus of goods/services.

Dictionary listings are the only evidence relied upon by the Examining Attorney. On the other side of the ledger, applicant has submitted the declarations of its chief executive officer and of seventeen individuals who are employed by companies which purchase melamine from applicant.

In light of the Federal Circuit's decision in American Fertility, we are constrained to find that the Examining Attorney, relying on dictionary definitions alone, failed to show, in the face of applicant's evidence, that the mark as a whole, MELAMINE CHEMICAL, INC., has acquired no additional meaning to purchasers of melamine than the terms "melamine," "chemicals" and "inc." have individually. To the contrary, these purchasers have stated under oath that they perceive the applied-for marks not as generic, but rather as designating source in applicant.

We would also point out that Gould involved a newly created product category, screen wipes, while applicant's

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product has been sold since 1968. As the Board stated in

In re Ferrero S.p.A., 24 USPQ2d 1155, 1157 (TTAB 1992):

Common sense leads us to conclude that if a term is generic for a type of a product that has been on the market for decades, evidence of its use by others in the marketplace should be available and should be considered.

See also, In re Volvo White Truck Corp., 16 USPQ2d 1417 (TTAB 1990). However, despite the fact that applicant has been selling melamine under MELAMINE CHEMICALS, INC. since 1968, the Examining Attorney has been unable to discover any generic uses of the term "melamine chemicals" either by applicant or any others in the field. This factor is particularly significant here.

We also note applicant's argument that there is a certain incongruity in its mark. Indeed, the Examining Attorney, in her supplemental brief, acknowledges that "[t]he mark is basically two terms repeating the same idea--melamine chemicals or 'chemicals, chemicals.'" If anything, the redundancy recognized by the Examining Attorney supports applicant's notion that the mark is somewhat incongruous and, therefore, distinctive. This incongruity weighs in favor of registrability.

In sum, in view of the Federal Circuit's decision in American Fertility, and after further consideration of the

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evidence of record in light thereof, we find that the Office has not met its burden of establishing by clear evidence that MELAMINE CHEMICALS, INC. as a whole is generic for the identified goods and services.

This brings us to the issue of whether MELAMINE CHEMICALS, INC. is merely descriptive and, if so, whether applicant has shown that it has acquired distinctiveness as a trademark/service mark.

A term is merely descriptive if it immediately conveys knowledge of the ingredients, qualities, or characteristics of the goods with which it is used. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). In the present case, we find that the mark as a whole immediately describes a primary characteristic of the goods and services, namely that they involve chemicals and, more specifically, melamine. Given the meanings of the terms in applicant's mark, MELAMINE CHEMICALS, INC. is merely descriptive of applicant's goods and services.

Having determined that the mark is descriptive of applicant's goods, we must now consider whether applicant has met its burden of demonstrating that its mark has acquired distinctiveness.

Applicant has furnished the declaration of Frederic Huber, applicant's president and chief executive officer.

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Mr. Huber begins by explaining that melamine is a specialty chemical with important uses in adhesives, molded plastics, and paints, and as a fire retardant. Melamine is generally sold to manufacturers in those industries in large quantities varying in size from 20 metric tons to 500 metric tons. Due to the nature of the melamine product and the target customers for melamine, Mr. Huber explains that applicant does not have a large advertising budget. Mr. Huber goes on to state, in pertinent part, that applicant was formed in 1968 and is the third largest manufacturer of melamine among the ten producers of melamine throughout the world (only three of which are located in the United States). According to Mr. Huber, applicant has been using the marks sought to be registered for its goods and services since 1968, and that this use has been continuous and substantially exclusive, pointing out that no other manufacturer of melamine has used the term MELAMINE CHEMICALS, INC. to designate its goods or services. Mr. Huber asserts that MELAMINE CHEMICALS, INC. is not a generic name for applicant's goods or services, but rather is a trademark/service mark recognized in the industry and by applicant's customers as indicating source or origin in applicant. Mr. Huber states that applicant's sales of

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melamine for the period 1990-1995 are in excess of \$231.5 million.

Applicant also has submitted form declarations from seventeen individuals who are employed by companies which purchase melamine from applicant. The declarants are either officers or managers of these companies. After setting forth the length of time that their companies have purchased melamine from applicant, the declarants go on to make the following pertinent statements:

The name MELAMINE CHEMICALS[,] INC. to me designates [applicant's] products and services and distinguishes them from those of others.

The name MELAMINE CHEMICALS, INC. to me designates a single source of origin of melamine and the custom supply of melamine and providing technical services in the field of melamine.

To my knowledge, no other manufacturer or seller of melamine has used or uses the name MELAMINE CHEMICALS, INC. to designate its products and services.

The name MELAMINE CHEMICALS, INC. to me is not a generic designation for melamine or the services of the custom supply of melamine and consulting in the field of melamine.

Upon further review of the evidence submitted by applicant, most particularly the declarations of those who purchase applicant's goods and services, we find that

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applicant has shown entitlement to claim the benefits of Section 2(f).

At the very least, the points raised by applicant in its request for reconsideration based on the Federal Circuit's recent decision, buttressed by the evidence of record, raise a doubt about this case. Although we have our concerns here about the genericness of applicant's mark, those doubts must be resolved in applicant's favor. The mark should be published, thus allowing a third party to file an opposition and develop a more comprehensive record. See, e. g., *In re Atavio*, 25 USPQ2d 1361 (TTAB 1992); *In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981); and *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972).

Decision: The request for reconsideration is granted. The refusals to register are reversed.

T. J. Quinn

C. E. Walters
Administrative Trademark
Judges, Trademark Trial
and Appeal Board